

REMARKS

I. Status of the Claims

Claims 1-2 and 4-25 are now pending in this application and stand rejected.
Claim 3 has been cancelled as discussed below. No new matter has been added.

II. Claim Objections

The Examiner objected to claim 3 under 37 C.F.R. § 1.75(c) for being of improper dependent form for failing to further limit the subject matter of a previous claim. Office Action at 2. In response, claim 3 has been cancelled and claim 4 has been amended to depend from claim 1 instead of claim 3. Accordingly, Applicants respectfully request the withdrawal of the Examiner's objection.

III. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-10 and 12-25 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,635,240 to Bolich et al. ("Bolich"), and claims 1-25 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 20010003584 to Birkel et al. ("Birkel"). Applicants respectfully traverse these rejections.

"A claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)) (emphasis added). Furthermore, a rejection under § 102 is proper only when the claimed subject matter is *identically described or disclosed* in the prior art. *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis added). The identical

invention must be described in "as complete detail as is contained in," and "the elements must be arranged as required by the claim." M.P.E.P. § 2131. Finally, the reference must direct those skilled in the art to the claimed invention without any need for picking, choosing, and combining various disclosures in the reference. *In re Arkley*, 455 F.2d at 587.

a) Rejection under 35 U.S.C. § 102(e) over Bolich et al.

The Examiner states that Bolich discloses "aerosol hair styling compositions which comprise (a) from about 5% to about 90% of a water soluble polyalkylene glycol (polyol) . . . ; (b) from about 1% to 90% of a liquid carrier; and (c) from about 5% to about 40% of a propellant." *Office Action* at p. 3. The Examiner further contends that Bolich discloses "additional styling agents to help improve initial hair hold performance in an amount of about 0.25% to about 5% . . . ," which include, among others, anionic polysaccharides. *Id* at p. 4. The Examiner finally points to "gelling agents" disclosed in Bolich. The gelling agents include crosslinked carboxylic acid polymers. *Id*.

Applicants respectfully submit that Bolich has not identically described the presently claimed cosmetic composition for the hair, nor does Bolich contain the elements of the presently claimed invention "arranged" as required by Applicants' claims. Instead, the Examiner appears to have selectively chosen aspects of Bolich and fashioned a grouping to read on the present invention. This is not the proper route to anticipation under section 102.

More specifically, Bolich provides no teaching or suggestion to one of ordinary skill in the art as to the *required* use of an anionic fixing polymer in combination with at least one polyol, a medium, and at least one propellant gas as recited in the present

claims. Indeed, there is no recognition of the merits of such a specific combination of ingredients. Bolich merely states that his compositions, which require a polyalkylene glycol, a liquid carrier, and a propellant, "may further comprise one or more optional styling polymers . . . ," which include polysaccharide polymers. *Bolich* at col. 6, ll. 47-49, 66. Bolich further states that "suitable polysaccharide styling polymers include anionic polysaccharides, cationic polysaccharides, and glucosamine polysaccharide derivatives." *Id.* at col. 6, l. 67-col. 7, l. 3. Cationic, nonionic and glucosamine polysaccharides are described in detail at col. 7-8, but Bolich provides no description whatsoever of anionic polysaccharides. Therefore, one of ordinary skill in the art would have to choose to add an optional styling polymer, and then specifically choose an anionic polysaccharide as the optional styling polymer, even though the teachings of Bolich provide no guidance for such a selection. Such picking and choosing cannot constitute the grounds for a proper anticipation rejection. Indeed, a reference cited under section 102 must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures" *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). The reference must therefore provide a certain degree of precision with respect to the specific composition claimed. The Bolich reference does not so provide.

Applicants note that the Examiner pointed to examples XIX to XX, presumably as examples containing an anionic polysaccharide. Applicants respectfully point out that examples XIX and XX include Ucare JR-400, which is erroneously called an anionic polysaccharide in the application. *Bolich* at col. 21. In fact, Ucare JR-400 is a *cationic*

polysaccharide polymer. *Id.* at col. 7, ll. 16-18 and *Attachment*. Accordingly, examples XIX and XX do not represent examples of compositions comprising an anionic polysaccharide, and, therefore, *Bolich* fails to teach or even suggest a composition containing all of the presently claimed elements "arranged" as in the present claims.

Alternatively, if one of ordinary skill in the art did not chose an anionic polysaccharide styling polymer, then one of ordinary skill in the art would still have to resort to picking and choosing various teachings in *Bolich*, for example, by making at least the following choices in order to arrive at the present invention based on the teachings of *Bolich*:

1. Choose to include an optional component, which includes silicone, propellant, and "other optional components." Other optional components include optional gelling agents. *Bolich* at col. 8, l. 61-col. 15 l. 63.

2. Specifically select an optional gelling agent as the optional component. *Id.* at col. 11, l. 55.

3. Select an anionic polymer as the gelling agent.

Accordingly, *Bolich* does *not* contain each and every claim limitation of the present claims as arranged therein, as is required for anticipation. See M.P.E.P. § 2131. On the contrary, *Bolich* requires picking and choosing from among numerous components in different parts of its 23-column disclosure in order to arrive at the presently claimed invention. See *In re Arkley*, 455 F.2d at 587. Such picking and choosing cannot support a rejection under section 102.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. Accordingly, the § 102(e) rejection should be withdrawn.

b) Rejection under 35 U.S.C. § 102(b) over Birkel et al.

Birkel describes a hair treatment composition containing: (A) at least one terpolymer of vinylpyrrolidinone, vinyl caprolactam and a basic acrylamide monomer, and (B) at least one polymer with anionic or anionizable groups. *Birkel* at [0008]-[0009]. According to Birkel, "polymer (B) can be an anionic polymer compound but also an amphoteric polymer compound." *Id.* at [0014]. Birkel further states that organic solvents can be contained in the composition as additional co-solvents in an amount of 0.1 to 15% by weight, and especially preferably of from about 1 to 10% by weight. *Id.* at [0027]. "Especially suitable" co-solvents are branched or unbranched hydrocarbons, such as cyclopentane and cyclohexane. *Id.* Additionally, Birkel states that ethylene glycol, glycerol and propylene glycol in an amount of up to 30% are especially preferred water soluble solvents. *Id.* Based on this disclosure, the Examiner asserts that "the use of the polyol . . . can be immediately envisaged by an artisan." *Office Action* at p. 7.

Applicants respectfully disagree. The disclosure of Birkel does *not* direct one of ordinary skill in the art to chose a polyol, but merely discloses ethylene glycol, glycerol and propylene glycol as one possible group of organic solvents that can be included in the composition of Birkel. One of ordinary skill in the art would have to choose to add a co-solvent and then select among branched or unbranched hydrocarbons, which Birkel characterizes as "especially suitable" as co-solvents, or ethylene glycol, glycerol, or propylene glycol, which are "especially preferred" as water-soluble solvents. Birkel at [0027]. Therefore, Birkel does not "clearly and unequivocally disclose the claimed [invention] without *any* need for picking, choosing, and combining various disclosures. . . ." *In re Arkley* at 587 (emphasis in original). On the contrary, Birkel

provides no guidance for selecting which optional co-solvent or solvent, if any, the artisan should choose. In fact, not one of the 10 examples in Birkel shows the use of any of these solvents or co-solvents.

Birkel further discloses that the hair composition can be in various application forms, such as a lotion, non aerosol spray, aerosol spray (sprayed by means of a propellant), aerosol foam, non-aerosol foam, cream, wax, gel, liquid gel, sprayable gel or foaming gel. Birkel states that if the treatment is in the form of an aerosol spray, it contains 15-85% of a propellant. Again, Birkel provides no guidance to one of skill in the art to choose an aerosol spray as the application form.

As with Bolich, the Examiner appears to have selectively chosen aspects of Birkel and fashioned a grouping to read on the present invention. Applicants submit that Birkel does *not* contain each and every claim limitation of the presently claimed invention arranged as in Applicants' claims. See M.P.E.P. § 2131. On the contrary, Birkel requires picking and choosing among numerous components in order to arrive at the present invention.

Therefore, Applicants respectfully submit that the criteria for anticipation have not been met. The § 102(b) rejection should accordingly be withdrawn.

IV. Double Patenting Rejections

a) Copending Application Nos. 10/796,016, 11/124,229, and 11/220,586

Applicants respectfully request that the nonstatutory obviousness-type double patenting rejections over

(1) claims 1-29 of copending Application No. 10/796,016 alone;

(2) claims 1-29 of copending Application No. 10/796,016 in combination with U.S. Patent No. 5,639,448;

(3) claims 1-25 of copending Application No. 11/124,229 in combination with U.S. Patent No. 5,639,448; and

(4) claims 1-20 of 11/220,586 in combination with U.S. Patent No. 5,639,448, be held in abeyance until allowable subject matter is indicated in the present application. See M.P.E.P § 804 I.B.

b) Claims 23-50 of copending Application No. 10/279,036 in view of U.S.

Patent No. 5,639,448

The Examiner has provisionally rejected claims 1-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-50 of copending Application No. 10/279,036 ("the '036 application") in view of U.S. Patent No. 5,639,448 ("the '448 patent"). *Office Action* at p. 14. The Examiner admits that the '036 application claims do not include at least 15% of a polyol. According to the Examiner, it would have been obvious to include polyols in the presently claimed concentration based on the teachings of the '448 patent. *Id.* at p. 15.

The '448 patent describes an aqueous composition containing a thermoplastic polyester fixative resin for thermo-styling hair. See, e.g. col. 3, ll. 49-65. The Examiner

asserts that one would have been motivated to use the presently claimed concentration of a polyol because "US '448 teaches the instant polyols are *conventionally* utilized as solvents and carriers." *Id.* at p. 15 (emphasis in original). Contrary to the Examiner's assertion, the '448 patent does not state that polyols are "conventionally utilized." The '448 patent merely states that other cosmetic additives can be incorporated in the composition. *The '448 Patent* at col. 13, ll. 56-59. One possible additive is an organic solvent, which can be added to solubilize compounds that are not sufficiently soluble in water. *Id.* at col. 13, ll. 64-67. Among these additives, polyols are "suitable solvents" for the composition that "can be present in an amount from about 1% to about 75%." *Id.* at col. 14, ll. 3-10.

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the '448 patent with the claims of the '036 application, as suggested by the Examiner. Applicants point out that evidence of a motivation to combine must be "clear and particular." *In re Dembiczak* 175 F. 3d 994, 999 (Fed. Cir. 1999). The Examiner has provided no evidence, let alone clear and particular evidence, of a motivation to combine the '448 patent and the '036 application claims. Nothing in the '036 claims or the '448 patent suggests a need for a polyol in the presently claimed amount, for example, to overcome any solubility in problems in water, as taught by the '448 patent.

The Examiner further relies on *In re Aller*, 220 F.3d 454, 456, for the proposition that "manipulation of concentrations of additives such as solvents encompassed by the prior art are considered to be prima facie obvious unless there is evidence indicating the amount is critical." *Office Action* at p. 15. The Examiner's citation of *In re Aller* is

inappropriate in the present context. The claims at issue in *Aller* were directed to a process of forming a specific, known chemical compound. The process differed from a prior art reference in lowering the temperature and increasing the concentration of acid used in the reaction. The court held that the process claims were obvious over the prior art because the increased yield of the desired compound from using the claimed acid concentration and temperature was a difference in degree, not in kind. *In re Aller* at 456. The difference resulted from changes in reaction conditions by the "routine efforts of the artisan." *Id.* at 457.

The present claims can be readily distinguished from the facts of *Aller* because here, the claims are directed to a composition, not a process for making a specific compound. The Examiner fails to explain how the conclusions of *In re Aller*, which were made in reference to a chemical process, can be extended to a composition as presently claimed. Moreover, the Examiner has provided no evidence that modification of the '036 claims by the addition of a polyol in the claimed amount would result from the "routine efforts of the artisan." For at least these reasons, Applicants respectfully submit that the '036 application claims and present claims are not obvious modifications of one another. Therefore, the rejection should be withdrawn.

c. Claims 1-36 of copending Application No. 10/479,170 in view of U.S.

Patent No. 5,639,448

The Examiner provisionally rejected claims 1-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/479,170 ("the '170 application") in view of the '448 patent.

Office Action at p. 17. As a preliminary matter, Applicants note that claims 1-19 of the '170 application have been cancelled.

The '170 application is directed to cosmetic compositions in an aerosol device containing a propellant liquid phase comprising (i) solid particles containing at least 10% by weight of a silicate and (ii) a fixing polymer and/or a thickening polymer. See '170 *Application*, claim 20. The Examiner admits that the '170 application fails to claim a polyol in the composition, and again relies on the '448 patent to teach the use of a polyol in the presently claimed amount. Again, the Examiner fails to explain how the '448 patent would have motivated one of ordinary skill in the art to modify the claims of the '170 patent. As Applicants explained above, the '448 patent does not teach that polyols are "conventionally utilized as solvents in the amount 1-75%" *Office Action* at p. 19.

The Examiner again relies on *In re Aller* for the proposition that the "manipulation of concentrations of additives such as solvents encompassed by the prior art are considered to be prima facie obvious unless there is evidence indicating the amount is critical." *Office Action* at p. 19. For the reasons explained above, Applicants submit that *In re Aller*, a case concerning a process of making a known chemical compound, is inapposite to the present invention.

Applicants submit that the '448 patent provides no motivation to one of ordinary skill in the art to use a polyol in the presently claimed amount in the claims copending in the '170 application. The Examiner has again failed to explain how the references provide any motivation to make the presently claimed composition. Accordingly, Applicants request withdrawal of the rejection.

CONCLUSION

In view of the above arguments and amendments, Applicants submit that the present claims are in condition for allowance. Prompt action by the Examiner is respectfully requested.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 22, 2006

By: _____


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Attachments: Amerchol Products Functional Overview for UCARE™ Polymer JR 400 from the Dow website.